

REMARKS

The examiner rejects claims 1-8 under 35 USC §103(a). Applicants respectfully traverse this rejection, as the cited prior art neither teaches each claim element, gives some suggestion or motivation to make the claimed invention, nor gives a reasonable expectation for success in doing so (*see, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

In particular, it is not clear from the examiner's argument *why* one of skill in the art would conclude that the x-ray diffraction pattern limitation would apply to each and every structure having the general formula $Ag_xV_2O_{5-y}$. As indicated in the specification, the molecular formula does not *necessarily* impute a specific crystal structure. Example 1 of the present invention produces $Ag_{0.73}V_2O_x$ having an x-ray diffraction pattern according to the present claims. Comparative Example 6 in the present specification produces $Ag_{0.73}V_2O_x$ according to the prior art, in which "the diffraction lines ... characteristic of the multimetal oxides of the present invention were not found."

(p.27:23-28) These oxides are identical in molecular formula, and yet one shows an x-ray diffraction pattern within the limits claimed, where the other does not. Accordingly, these "naturally obtained ... unique physical properties," as the examiner calls them, are unique to only a certain subset of $Ag_{0.73}V_2O_x$ oxides, and not to all oxides of that molecular formula. The x-ray diffraction pattern element is not inherent in the recited multimetal oxides, as the pattern is not *necessarily* present.

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Takada discloses silver-vanadium oxides, including an oxide with the molecular formula $\text{Ag}_{0.7}\text{V}_2\text{O}_5$, and yet does not disclose any information concerning the x-ray diffraction pattern of the oxide. Without some teaching that the x-ray diffraction pattern in the Takada oxides is different from that of other prior art, there is no suggestion for making such an oxide, and no reasonable expectation of success. Accordingly, no *prima facie* case can be established based on Takada in light of the specification's teaching concerning x-ray diffraction patterns in prior art oxides.

Applicants respectfully request that the rejection under 35 USC §103(a) be withdrawn and that the application be passed to issuance.

Respectfully submitted,
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'David C. Liechty', with a stylized flourish extending to the right.

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